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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,542	05/22/2001	Robert Alan Reeves	STEV-109	1268

7590 06/23/2003  
ROBERT E. STRAUSS  
74527 Moss Rose Drive  
Palm Desert, CA 92260

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/862,542

Applicant(s)

REEVES ET AL.

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 6-17 is/are pending in the application.
- 4a) Of the above claim(s) 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Rejections not maintained are withdrawn.

#### ***Claim Rejections - 35 USC § 112***

3. Claims 2-3, 6-8 and 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the structural relations of the backing coat to the indicia coat and carrier sheet is vague and indefinite, i.e., it is not clear whether backing coat is adhered to indicia coat and carrier sheet. Also, at line 4, the phrase "substantially covering said indicia." is vague and indefinite. Clarification is requested.

In claim 8, line 1, please correct "claim I" to --claim 1".

#### ***Response to Amendment***

4. Claims 1-3, 6-8 and 16-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Markar et al. (US 5908694).

Markar's invention is directed to a heat-transfer label for use on untreated polyethylene surfaces and the like (column 1, lines 4-6). In Fig. 2, Markar teaches a

heat-transfer label 111 comprises a support (or carrier) layer 113 and a transfer portion 121. Transfer portion 121 preferably includes a protective lacquer layer 123 directly on top of a portion of wax release layer 115, and an ink design layer (or indicia coat) 125 printed onto a desired area of lacquer layer 123. The heat-activatable adhesive layer (or top coat) 127 is coated over the design layer 125 and onto a surrounding portion of wax release layer 115 (column 10, lines 6-18).

For claims 1 and 8, although Markar lacks express teachings of the composition of the indicia coat (or design layer) and the melting temperature of the top coat (or heat-activatable adhesive), it is believed that a design layer comprising a indicia material and hydrocarbon wax is either inherently disclosed or an obvious selection of materials to one skilled in the art, as evidenced by Noguchi et al. (US 5606356), which directed to an ink for heat transfer, etc. (column 1, line 14). Noguchi teaches that it is known art that in order to prevent running and strike-through of the ink and to keep the printed image quality by adjustment of the ink formulation, a solid component like a wax and a polymeric compound is added to the ink with the dye component (column 2, lines 7-12); further, since the scope of Markar's heat transfer label, i.e., a heat transfer for polyethylene surface, are essentially the same as the instant claimed invention, it is also believed that selecting a heat-activatable adhesive layer with suitable melting temperature is also either inherently disclosed, or an obvious optimization to one of the ordinary skill in the art. As to the recitations pertaining to the process of using the transfer in a rotational mold, the Examiner notes that the process limitations have not

been shown on the record to produce a patentably distinct article, as such they are insignificant and bears no weight in an article claim.

For claims 2-3 and 7, Markar's wax release layer 115 clearly reads on the instantly claimed backing coat. Markar teaches that when sufficient heat is provided, the transfer portion 121 and a portion of wax release layer 115 is released from support portion 113 and the adhesive layer 127 is also heat-activated for bonding of transfer portion 121 to the desired article (column 11, lines 59-62). Further, Markar teaches that the wax layer 115 must be fixed sufficiently to the transfer portion 121 to prevent a shrinkage or expansion of one or more of the constituent layers of transfer portion 121 (column 10, lines 25-37). Although Markar lacks an express teaching that the wax release layer is a pressure sensitive adhesive at ambient temperatures and its melting temperature is less than the molding temperature, it is believed that the aforementioned elements are either inherently disclosed or an obvious optimization to one of ordinary skill in the art, motivated by the desire to hold to layers together and also becomes releasable from the support portion 113 at the transfer temperature. Additionally, note also as evidence that Markar teaches that it is known art that a wax release layer is affixed to the paper sheet. As the paper sheet is subjected to heat, the wax layer begins to melt so that the paper sheet can be released from the ink design layer, a portion of the wax layer being transferred with the ink design layer and a portion of the wax layer remaining with the paper sheet (column 1, lines 20-33).

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For claim 6, Markar shows in Fig. 2 that the design layer (or indicia area) is enclosed by the wax release layer (or backing coat) and the heat-activatable layer (or the top coat).

For claim 16, the heat-activatable adhesive layer (or top coat) of Markar comprises polymeric materials (column 14, lines 45-49), which is inherently based on hydrocarbon resins.

For claim 17, it is believed that the wax release layer is inherently a hydrocarbon wax.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC  
June 16, 2003

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1900-  
1700

*Daniel Zinker*